

REMARKS

This amendment is in response to the Official Action mailed on May 21, 2004. Applicants have amended claims 31, 35, 41, 47, 52, 53, 58, 63 and 68-72. Claims 31-72, as amended, are presented for the Examiner's consideration in view of the following remarks.

As an initial matter, in the Office Action Summary, the Examiner checked box 12(c) indicating that certified copies of the priority documents have not been received. However, Applicants note that the present invention is a nationalization of an International Application (PCT/JP99/06242) and that accordingly, certified copies of the priority documents do not need to be filed with the U.S. Patent and Trademark Office. Moreover, Applicants note that the Notification Of Acceptance Under 35 U.S.C. § 371, issued by the U.S. Patent and Trademark Office on August 10, 2000, has been received. In view of the foregoing, Applicants submit that the present application is entitled to priority of Japanese Application Nos. JP 322299/1998 and JP 333255/1998 without the filing of certified copies of same.

I. Section 102(a) - Brown

In summary, the present application contains twelve independent claims including independent claims 31, 35, 41, 47, 52, 53, 58, 63, 68, 69, 71 and 72. Of these claims, claims 31, 35, 41, 47, 52, 53¹, 63, 68, 69, 71 and 72 were rejected under 35 U.S.C. § 102(a) as being anticipated by International Publication Number WO 92/22983 to Brown et al. ("Brown"). Various dependent claims (claims 32, 33, 36, 37, 43, 44, 48, 49,

¹ Applicants note that claim 53 is a corresponding apparatus claim to method claim 35. While claim 53 had not been specifically mentioned or rejected in the Official Action, claim 35 was listed as rejected in paragraph 2 of the Official Action. Applicants thus assume that the Examiner intended to also reject apparatus claim 53 on the same grounds as method claim 35.

54, 55, 64 and 65) were also rejected under § 102(a) in view of *Brown*.

A. Independent Claims

With respect to claim 31, Applicants submit that this claim is not anticipated by *Brown* for a number reasons. As an initial matter, the Examiner states that as to the "digital interface" limitation, *Brown* discloses many digital interfaces including digital outputs 112g and 112h. It is noted by the Examiner that output 112g may be used to send decompressed digital data to a digital television receiver. However, these digital outputs merely send output signals to external devices (e.g., recorders, TV monitors) and do not receive a transport stream, let alone the compressed, multiplexed transport stream from an external reproducing apparatus.

As to the "display processing circuit" limitation, the Examiner states that controller 105 of *Brown* allows the user to access and control the multi-source recorder player 100 and that the analog input 112a may be set to receive control screens as described and shown in Figures 2-11 of *Brown*. It is noted, however, that the claimed display processor circuit of claim 31 is not present in *Brown* given that *Brown* displays what is recorded in the player 100 itself, not what is recorded on a medium in an external recording apparatus.

Finally, the Examiner notes that the source column in the program list screen 600 of *Brown* indicates the originating source of the signal, thereby meeting the claim limitation of claim 31 that the display processing circuit displays a message showing that a recording mode of the recorded program loading in the reproducing apparatus indicates a digital recording. Again, this limitation is not present in *Brown*. First, *Brown* does not have its recorded programs reproduced by its player 100 via a digital interface to an external recorder. Second, *Brown's* player always records digitally and compressed to storage

section 104 (see pages 10-11). Figure 6 of *Brown* only shows the input source and not the *recording mode* (i.e., whether the input source was recorded in an analog or digital mode). *Brown*, therefore, will not show the recording mode since the recording mode is always digital.

Applicants note that the above remarks also apply to the rejection of independent claim 68, a method claim corresponding to independent claim 31.

With respect to independent claims 35 and 41, and their corresponding claims 53 and 69, the Examiner states that *Brown* displays the source type (e.g., DBS v. cable), which meets the claim limitation of displaying a message showing that a recording mode of the program recorded on a recording medium loaded in the reproducing apparatus indicates an analog recording or a digital recording. However, this is not the case given that the display of the source type in *Brown* displays the source from which the program that was recorded originally came from, not the recording mode by which the incoming signal was recorded. Again, this is because *Brown* records all of the incoming signals in digital form and would not need to specify whether the program recorded in the recording medium was recorded in analog or digital form.

With respect to independent claims 47 and 71, as an initial matter, the Examiner does not identify what corresponds to the previously claimed "reading means" for reading out information associated with the program recorded on the recording medium. As an aside, it is noted that Applicants have amended the term "reading means" to recite a CPU programmed for retrieving the information such that this limitation is no longer presented in means-plus-function format. In any event, besides this lack of correspondence in *Brown* with the claimed CPU limitation, it is clear that *Brown* does not retrieve information from a memory in an external recording apparatus

and, therefore, does not include a display processing circuit or step for displaying the information associated with the program recorded on the recording medium loaded in the external apparatus on the basis of information retrieved by the CPU from a memory in the external recording apparatus.

With respect to independent claims 52 and 72, again, the Examiner does not identify the reading means (now CPU) that finds correspondence in *Brown*. Moreover, the Examiner does not indicate that *Brown* includes a process to display a message showing that the program recorded on the recording medium in the external reproducing apparatus indicates a recording mode in which the digital signal cannot be decoded by the receiving apparatus. With the present invention, should the digital signal that is recorded in the recording medium in the external reproducing apparatus be unable to be decoded by the receiving apparatus, a message will be shown, such as an error message as shown in Figure 6 with the display reading "Different system. Cannot be displayed."

Finally, with respect to independent claim 63, the Examiner indicates that the source column in the stored program list screen 600 of *Brown* indicates the originating source of the signal. While this is the case, claim 63 as presently amended clarifies that a message is displayed, as with claim 52, that in the case where digital signal reproduced by the external reproducing apparatus cannot be decoded in the decoder based on the predetermined transport stream format, a message is displayed indicating that the program is recorded in a format whereby the digital signal cannot be decoded by the receiving apparatus.

B. Dependent Claims

Dependent claims 32, 36, 43, 48, 54 and 64 relate to the displayed information of the claimed receiving apparatus or method. It is submitted that these dependent claims are not

anticipated for the reasons discussed above with respect to the independent claims from which they depend. Moreover, given that *Brown* does not reproduce the transport stream from an external reproducing apparatus, it also does not display information about the program recorded on the recording medium located in the external reproducing apparatus, and therefore, does not display the claimed information associated with a program recorded on a recording medium loaded in an external reproducing apparatus.

With respect to dependent claims 33, 37, 44, 49, 55 and 65, it is submitted that these claims directed to recording position information are also not anticipated for the reasons discussed above with respect to their independent claims. Further, it is submitted that these claims are also not anticipated by *Brown*, which does not display recording position information of the program on the recording medium. Applicants disagree that the recording position in *Brown* is inherently displayed. While position information may be needed and stored somewhere to retrieve the programs stored in internal storage section 104 of *Brown*, it is not disclosed nor inherent that recording position information of the physical location of the program on the recording medium is displayed. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See M.P.E.P. § 2112; *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). By contrast, with the present invention, as described with respect to Figure 10, a portion where a program has been recorded is displayed, for example, with a different color so that it is possible to readily find the position of the program of interest in the range of the start to the end of the videotape. This would be indicated, for example, with bar display 59 as shown in Figure 10.

II. Section 103(a) -- Brown and Yuen

The Examiner has rejected dependent claims 34, 38, 45, 50, 56 and 66 based on the combination of *Brown* and U.S. Patent No. 6,147,715 to Yuen et al. ("*Yuen*"). The Examiner notes that *Brown* fails to explicitly disclose information associated with a program that is "overlapped" or overlaid on a reproduction signal. The Examiner states that Yuen discloses information associated with a program that is overlapped or overlaid on a reproduction signal to provide the user with information in a convenient fashion. As an initial matter, Applicant respectfully submits that these dependent claims are not anticipated or rendered obvious for the reasons discussed above with respect to their independent claims. Further, these dependent claims call for the information associated with the program to be overlapped to the reproduction signal. In Yuen, however, the tape index guide from the VCR is not overlapped to the reproduced picture. Rather, the reproduced picture from the VCR is overlapped on top of the guide screen as shown in Figure 7 of Yuen.

III. Section 103(a) -- Brown and Ohno

Independent claim 58 was rejected by the Examiner as being obvious over *Brown* in view of U.S. Patent No. 5,761,371 to Ohno ("*Ohno*"). The Examiner notes that *Brown* lacks the display of a compression type, but alleges that *Ohno* teaches displaying based on the kind of compression, citing to Figure 6 and the description of providing the user with information of the recording speed on which the program is recorded on the tape (e.g., standard or triple speed). This indication of recording speed, however, is not the type of compression format of the incoming signal and thus the combination of *Brown* and *Ohno* would not display a message showing that the program recorded on the recording medium is recorded in a compression mode in which the

digital signal cannot be decoded by the receiving apparatus. Rather, in *Ohno*, whatever speed the program is recorded in (e.g., standard or triple speed), it can be reproduced. With the present invention, there may exist a situation in which the compression format of the program recorded on the recording medium is incompatible with the decoding operation in the decoder, such as when the decoder can play back MPEG2 compressed data only, and the program recorded on the recording medium loaded into the recording reproducing apparatus has a different compression format than MPEG2, such as non-MPEG2 digital HDTV signals.

The Examiner has also rejected dependent claims 39, 40, 46, 51, 57, 62 and 67 based on the combination of *Brown* and *Ohno*. First, it is submitted that these claims are not rendered obvious for the reasons discussed above with respect to their independent claims. Moreover, these dependent claims call for the information being associated with the program to include information of the recording mode of the recorded program. Again, while *Ohno* does disclose the display of the recording speed (e.g., standard or triple speed), *Ohno* does not state the mode of recording such as whether the mode is analog or digital.

Finally, the Examiner has rejected dependent claims 59 and 60 based on the combination of *Brown* and *Ohno*. Applicants maintain that these claims are not rendered obvious and reiterate their remarks above with respect to similar dependent claims (e.g., dependent claims 32 and 33).

IV. Section 103(a) -- Brown

The Examiner has also rejected independent claims 52 and 70 as being obvious over *Brown*. The Examiner states that *Brown* does not disclose displaying a message showing a recorded program cannot be decoded but that it would be obvious to do to display such message so as to notify the user of any problems that might arise. Applicants respectfully submit that not only

does *Brown* lack the elements discussed above with respect to the rejection of claims 52 and 72 under Section 102(a) in view of *Brown*, but Applicants further submit that it would not have been obvious to have the apparatus including the decoder (e.g., an IRD) display a message that the display apparatus cannot decode the program which is presented to it by an external reproducing apparatus. The present invention solves this problem by presenting indication to the user that the format of the program recorded on the recording medium in the external recording apparatus cannot be displayed through the receiving apparatus and, thus, the user is able to switch inputs, for example, between analog and digital inputs. Thus, messages such as "During analog reproduction. Cannot be displayed" and "Different system. Cannot be displayed" are displayed so that the user can readily recognize the cause by which the reproduction picture cannot be displayed so that he or she can take necessary countermeasures to select the proper input switching or the like.

The Examiner has further rejected dependent claims 42 and 70 under Section 103(a) in light of *Brown*. Such claims relate to the display of an alarm when the user selects a digital input/output. The context of this display is an alarm that when a recording medium is loaded in an external recording apparatus in which a transport stream has different specifications or is of a system capable of being decoded by the receiving apparatus, an alarm indication is displayed as previously described. *Brown* simply does not face this problem. Again, for the same reasons discussed above with respect to independent claims 52 and 72, Applicants respectfully submit that dependent claims 42 and 70 are also not rendered obvious in view of *Brown*, which would not need to display an alarm based on the digital input/output selection.

V. Section 103(a) - Brown, Ohno and Yuen

Finally, dependent claim 61 has been rejected as being obvious over *Brown* in view of *Ohno* and further in view of *Yuen*. This dependent claim calls for the program to be overlapped to a reproduction signal as specified in previously discussed dependent claims 34 et al. Again, for the reasons discussed by Applicants with respect to rejection of these dependent claims based on *Brown* and *Yuen*, Applicants respectfully submit that such dependent claim is not rendered obvious by combination of references cited by the Examiner.

VI. Conclusion

Based on the foregoing, Applicants respectfully submit that none of the present claims are anticipated or rendered obvious by any of the cited prior art, alone or in combination. Accordingly, Applicants respectfully request the Examiner to withdraw the rejections of the claims under Section 102(a) and Section 103(c).

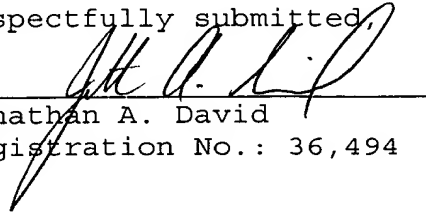
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: July 26, 2004

Respectfully submitted,

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